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NO. 806

IN THE

Supreme Court of the United States

OCTOBER TERM, 1968

WAYNE KNITTING MILLS AND THE MAY CORPORATION,
Petitioners

vs.

RUSSELL HOSIERY MILLS, INC., *Respondent*

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT AND APPENDIX

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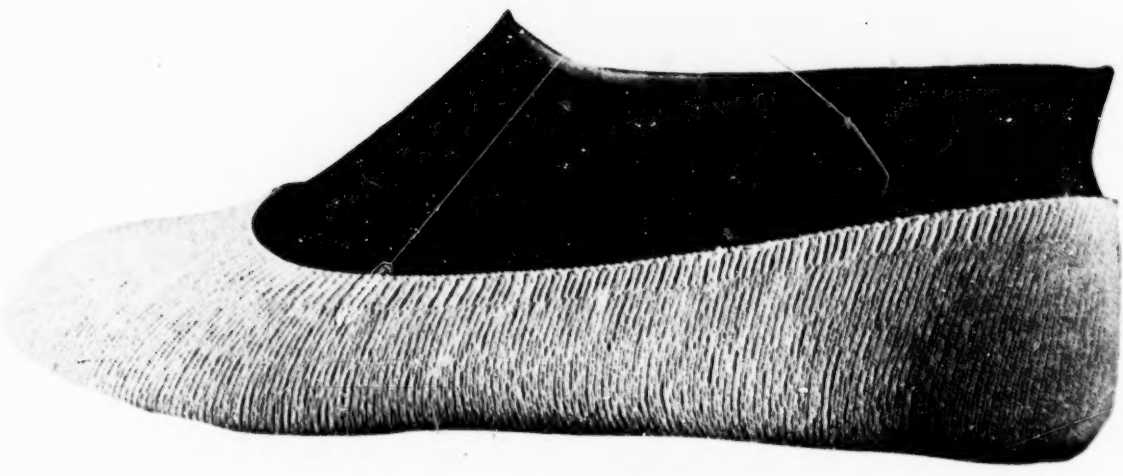
Petitioners' **SONLINER** foot sock
(Plaintiffs' Exhibit No. 2)

i) Flat

ii) On foot form



Petitioners' SONLINER foot sock
(Plaintiffs' Exhibit No. 2)

iii) On foot form within the shoe

IN THE

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OCTOBER TERM, 1968

NO. ____

WAYNE KNITTING MILLS AND THE MAY CORPORATION,
Petitioners

VS.

RUSSELL HOSIERY MILLS, INC., *Respondent*

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

To the Honorable, The Chief Justice of the United States and the Associate Justices of the Supreme Court of the United States:

Petitioners respectfully pray that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Fourth Circuit reversing a final judgment of the United States District Court for the Middle District of North Carolina, wherein originally the petitioners were plaintiff and the respondent was defendant.

OPINIONS BELOW

The opinion and judgment of the United States Court of Appeals for the Fourth Circuit appear as Appendix A and Appendix B to this petition. The opinion and judgment of the United States District Court for the Middle District of

North Carolina are reported at 274 F. Supp 934 and appear at pages 2-22 of the respondent's Appendix for Appellant filed in the Court of Appeals.[1]

JURISDICTION

The opinion and judgment sought to be reviewed were entered by the United States Court of Appeals for the Fourth Circuit on September 10, 1968, were reported at 400 F.2d 964 and appear as Appendix A and Appendix B of this petition. The jurisdiction of this Court to review by writ of certiorari the judgment in question is conferred by Title 28, United States Code, Section 1254(1).

QUESTIONS PRESENTED

(1) Did the Court of Appeals err in reversing the trial court by holding that the specification and drawings of the patent in suit could not be referred to for the purpose of construing the claim in issue so as to avoid overclaiming?

(2) Did the Court of Appeals err in reversing the trial court by imposing too stringent and unduly harsh a test of particularity in holding that 35 U.S.C. § 112 requires the claim in suit to specify the particular location of the laid-in rubber rim on the foot of a wearer?

STATEMENT OF THE CASE

The product of the Sarbo patent in suit is a knitted article of ladies' footwear designed to be worn on the foot without showing above the top of the shoe, to give the "bare legged" look when worn (as it customarily is) without conventional socks or hosiery. An actual ladies' foot sock, produced according to the invention, is presented in the Index p. V;

[1] Copies of the record in the district court as printed for use in the United States Court of Appeals for the Fourth Circuit are filed herewith by stipulation, pursuant to Rule 21(1). Such record consists of a gray pamphlet labeled "Appendix for Appellant" and a blue pamphlet labeled "Appendix for Appellee." Because of the length of the District Court Opinion, it is not reproduced as a separate appendix to this petition, but appears at DA 2-22, pursuant to the authority of Rule 23(i).

photographs of this footsock appear in the Index pp. iii and iv; also in Appendix for Appellee, pp. 205 and 206.

The subject matter of the patent in suit was developed by Edgar G. Sarbo in Vienna, Austria in 1958. Sarbo is a naturalized U. S. citizen by virtue of combat service in the United States Army in World War II. Prior to his invention, shoe-top-length foot socks adapted for wear with low cut shoes were available in the market in two forms:

1) a sock such as "Peds" and "Footlets" (Photographs: Appendix for Appellee 225-227) made from flat knitted fabric (as distinguished from tubular seamless knitted fabric as in the Sarbo sock) which was cut from such fabric and then sewn into the desired shape and provided with a sewn-in elastic rim around the foot entry opening, and

2) a sock such as respondent's style 6335 (Photograph: Appendix for Appellee 224) knitted as a conventional sock with a short top with reciprocartorily knit heel and toe pockets, which sock would thereafter be cut down at the top and instep and provided with a sewn-in elastic rim around the foot entry opening. Finding of Fact 4, Appendix for Appellant 6.

Thus, each of these prior art types of socks involved cutting of the fabric, and each involved the sewing in of a heavy elastic band around the foot entry opening. These shoe-top-length foot socks were not only comparatively expensive to manufacture, due to the fact that the cutting and sewing had to be performed in addition to slow reciprocation, but also, were rather uncomfortable by reason of the fact that the heavy band or rim of elastic provided around the foot opening tended to burrow into the foot of the wearer due to the pressure of the shoe. Cutting and sewing is a time consuming operation requiring skilled operators and entailing considerable waste. Finding of Fact 4, Appendix for Appellant 6.

In early 1958, Sarbo, a sock manufacturer who was not engaged in manufacturing shoe-top-length foot socks, became aware of the deficiencies of the available shoe-top-

length foot socks. Sarbo approached the problem as one to be solved within the capabilities of his operations and his machinery, which did not employ cutting and sewing operations, and finally, conceived of his invention. Appendix for Appellant 41.

The significance of Sarbo's invention became apparent immediately, and on November 19, 1958, Sarbo filed an application for Letters Patent in Austria. Thereafter, on November 12, 1959, Sarbo filed a corresponding patent application in the United States which eventually matured into the Sarbo patent in the suit, No. 3,059,458, Appendix C herewith and Appendix for Appellant, pp. 23-25. The United States application was prepared upon the instruction of Sarbo's Austrian attorneys and, so far as Sarbo understood, in accordance with the requirements of the United States patent laws.

In addition to Austria and the United States, patents on Sarbo's invention have also been granted by Argentina, Belgium, Canada, Denmark, Finland, France, Germany, Great Britain, Greece, Italy, Luxemburg, Norway, Spain, Sweden and Switzerland. In addition to granting rights to others under his United States patent, Sarbo had already licensed his patent rights in Germany, Spain and Switzerland at the time of trial. Findings of Fact 7 & 8, Appendix for Appellant 8. The petitioner, Wayne Knitting Mills, is the assignee of the United States patent by mesne conveyances. Findings of Fact 1 & 2, Appendix for Appellant 5.

Just when respondent Russell first became interested in the shoe-top-length foot sock field is not clear from the record. However, sometime prior to 1964, Russell did enter the field with a cut and sewn shoe-top-length foot sock.

In 1964, Russell saw one of May's Sarbo-type foot covers and, after some experimentation, developed and thereafter commenced selling its Style 1335A, which style was *identical* to the May product in every material respect and employed every element of Claim 3 of the Sarbo patent. Appendix for Appellee 48,60. Photographs of the Style 1335A sock ap-

pear at Appendix for Appellee, p. 207.

After formal notice of infringement of the Sarbo patent, Russell thereafter devised two additional Sarbo-type socks, Style 1334B and Style 1334C, one of the purposes for doing so admittedly being to avoid infringement of the Sarbo patent. Stipulation of Fact 44, Appendix for Appellant 123. A photograph of Style 1334C appears at Appendix for Appellant, p. 208. Style 1334B involves reciprocatory knitting and at the time of trial had never been commercially produced and has not been placed in issue in this case. Style 1334C incorporates a 50 denier, two-ply yarn in the upper body portion and a 70 denier, two-ply yarn in the lower body portion, the stitches from the 70 denier yarn being drawn slightly longer than those from the 50 denier yarn. Except for these changes, Style 1334C is identical to Style 1334A, and all of the elements of Claim 3 of the Sarbo patent are also found in Style 1334C. Appendix for Appellant 37-38; 59-61.

Suit for infringement was instituted by the petitioner in the United States District Court for the Middle District of North Carolina under Title 28, § 1338(a) of the United States Code. The trial court held that patent was valid and infringed by the respondent. On appeal by the respondent, the trial court's judgment was reversed by the Court of Appeals on the ground that the claim in suit is invalid for overclaiming and for indefiniteness under 35 U.S.C. § 112.

Another suit for infringement has been initiated by Petitioner in the United States District Court for the Western District of North Carolina (Charlotte), also under Title 28, § 1338(a) of the United States Code. Trial of this suit styled *May Hosiery Mills et al* v. *Moretz Hosiery Mills, Inc. et al* (Civil Action No. 2014) awaits this Court's decision upon the present petition.

REASONS FOR ALLOWANCE OF WRIT

Introduction

This is a case in which the United States Court of Appeals for the Fourth Circuit, in overthrowing the trial court's

finding of validity, improperly and contrary to the decisions of this Court, refused to interpret the claim in suit by reference to the four corners of the patent, *i.e.*, the drawings and specification, and imposed much too rigorous and stringent a test for construing the language of the claim in determining whether or not it satisfied the requirements of Section 112 of Title 35. In doing so, the Court of Appeals decided an important question of federal law in a way in conflict with applicable decisions of this Court and also in conflict with principles of law enunciated in decisions of other Circuit Courts of Appeals.

The following three paragraphs which conclude the opinion of the Court of Appeals in this case are critical to the understanding of this petition and the petitioner sets them out for the convenience of the Court:

> "From plaintiffs' argument and the district judge's conclusion, it is apparent that the lower location where the laid-in rubber rim serves its function is critical to the validity of Sarbo Claim 3, both as to inobviousness and new function. Yet, the exact location of the rim is not identified anywhere in the claim. At most, the claim implies a location below the ankle, but plaintiffs and the court below predicate the validity of the claim, not on the entire area below the ankle, but on the undetermined location below the ankle where the ankle ceases to resemble the cylindrical conformation of the leg and exhibits the irregular configuration of the foot. Specifically, Sarbo Claim 3 gives no particularity as to the part or shape of the foot or leg portion the rim contracts against or where it is located relative to the instep. While this claim recites that the body does function as "tip, sole and heel portions" of the foot cover, absent is any language to exclude the body from also covering part of the instep, the ankle or parts of the foot in the area below the ankle.
>
> Lacking language disclosing how the patented device should be constructed so as to position the elasticized rim below the ankle in the place where it can perform its theretofore undiscovered—and hence new and novel —function, the claim, in our view, is invalid, because it is so broad that it claims as invention that which

plaintiffs concede was not new. Stated otherwise, by the breadth of the claim that which is conceded to have been known in the prior art—that which the prior art anticipated or made obvious—is included within the claimed invention; hence, the claim is invalid for overclaiming. *Schriber-Sibroth Co.* v. *Cleveland Trust Co.*, 305 U.S. 47 (1938). See also, *Heyl & Patterson, Incorporated* v. *McDowell Company*, 317 F.2d 719 (4 Cir. 1963). And the drawings cannot properly be referred to for the purpose of narrowing the claim. *Binks Mfg. Co.* v. *Ransburg Electro-Coating Corp.*, 281 F.2d 252, 256 (7 Cir. 1960). Cf. *Wilcox Manufacturing Co.* v. *Eastern Gas & Fuel Associates*, 400 F.2d 960 (4 Cir., Decided Sept. 10, 1968.)

It follows, also, that by failure to specify the critical location of the laid-in-rubber rim the claim of the patent is invalid for failure to satisfy 35 U.S.C. § 112. The mandate for a particular and distinct claim of the subject matter constituting the invention was not satisfied. *Wilcox Manufacturing Co.* v. *Eastern Gas & Fuel Associates*, supra; *Triumph Hosiery Mills, Inc.* v. *Alamance Industries*, 299 F.2d 793 (4 Cir. 1962)."

In the above-quoted paragraphs the Court of Appeals not only requires that Claim 3 identify the *exact* location of the rim of the foot cover on the foot but also refuses to consider the drawings or to give full value to the patent specification in determining the scope of Claim 3. In both respects, the Court of Appeals erred to the detriment of petitioners' highly sucessful invention.

1. The Court of Appeals erred in holding that the specification and drawings of the patent in suit could not be referred to for the purpose of narrowing the claim and thus avoiding overclaiming.

The claim in suit reads as follows:

"3. A knitted *foot cover* comprising a seamless tubular rim including at least some rubber threads,

Said rim being adapted to form an opening for a foot entry,

a seamless tubular *body* having an axial length greater than that of said rim and connected with said rim,

said rim and said body, each, respectively, consisting

of the same knitting structure throughout its entire axial length and throughout its entire periphery and a seam formed at the end of said body opposite said rim, to form a *symmetrical pouch-like body,* and *said body being adapted to function as tip, sole and heel portions of said foot cover.*" (emphasis supplied)

The description of the specification reads in part as follows:

"It is an object of the invention to provide an improved method of manufacturing *undersocks or foot covers.* In one respect, methods of the invention are characterized in that a seamless tube is formed which consists of a continuous sequence of tubular elements each of which corresponds to an *undersock or foot cover and each of which consists essentially of a rim having an integrated* rubber thread and a body." (emphasis supplied)

* * * * *

"The upper rim of the product is very flat and has an excellent elasticity.

Illustrative embodiments of undersocks or foot covers made according to the invention will next be described and are diagrammatically illustrated in the accompanying drawing in which:"

* * * * *

"*FIG. 5 shows a foot cover forming an end product of the method of the invention.*

In the drawing, seamless tube 1 consists of periodically recurring hose elements each of which corresponds to one foot cover. *Each hose element consists essentially of three sections, namely a rim 2 a body 3 and a surplus course.*" (emphasis supplied)

* * * * *

"During the knitting of the rim 2, a rubber thread 5 is incorporated or inserted in the yarn by means of a conventional rubber feeding device as is known for hosiery machines. This rubber thread is inserted in the manner of a woven fabric (FIG. 4a) such that the rubber thread lies substantially along the periphery of the rim and transversely of the knitting direction. The rubber thread can be wound with the same tension as the other threads, so that when the tube is withdrawn from

the machine, the resilience of the rubber thread causes reduction in the diameter of the rim portion 2 as seen in FIG. 2. *Rim 2 in the illustrated embodiment has a length of about 1 cm.* At the translation from the rim 2 to the body 3, the rubber thread is ommitted and knitting of the hose is continued. *The length of this body depends on the material used and may be, for example, about 4-6 cms.*" (emphasis supplied)

* * * * *

"*The desired result thus can be achieved only with a very high stretchability and elasticity which insures at the same time a good hugging of the foot by the foot cover.*

FIG. 5 shows a foot cover in use." (emphasis supplied)

Figure 5 of the drawings in the patent is reproduced herewith:

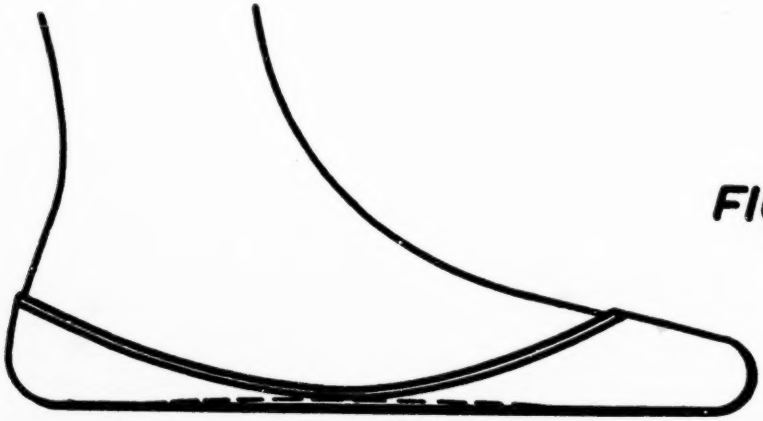

FIG. 5

Petitioners strongly contend that the Circuit Court, *on the basis of an issue that was never even presented to the trial court by the respondent* (respondent's charge of indefiniteness in the trial court was limited to Claim 3's use of the terms "knitting structure" and symmetrical"), improperly held that Claim 3 is invalid for overclaiming and for failure to comply with 35 U. S. C. § 112 through a misunderstanding of the wording of Claim 3 and through a further misunderstanding of the established principle of law which

would require that the Court interpret the language of Claim 3 in the light of the description in the specification and FIG. 5 of the drawings.

Claim 3 states at the outset that it relates to a "foot cover," thus establishing that the sock to which it relates is one which is adapted to cover the *foot* and not the ankle or leg. If the inventor had intended to claim a conventional sock to fit both the foot and leg or ankle, he would no doubt have referred to it as such. Claim 3 then refers to three elements, (1) the rim, (2) the body and (3) the seam, concluding with the statement that the body is adapted "to function as tip, sole and heel portions of said foot cover." The Circuit Court held that "while thi claim recites that the body does function as 'tip, sole and heel portions' of the foot cover, absent is any language to exclude the body from also covering part of the instep, the ankle or parts of the foot in the area below the ankle." Petitioners submit that the implication of the term "foot cover" and the reference to the body as covering the "tip, sole and heel portions of said foot cover' makes it clear that the inventor was claiming as his invention a structure which was located on the foot entirely below the ankle and below the instep in such a manner as not to be visible above the shoe top. For the Circuit Court to have held that the body of the sock might also have covered other portions of the foot or ankle was entirely unreasonable in view of the obvious intention of the draftsman of the claim to limit the claim to a below the shoe-top sock. If the claim had been intended to cover other portions of the foot, it would have made reference to those portions of the foot in the concluding phrase.

At the very least, the Court was placed under an obligation, if it had any difficulty in understanding the term "foot cover" and those portions of the foot which the foot cover was intended to encompass, to refer to the description of the specification and drawings in order to ascertain the meaning of the patentee's terminology. This it absolutely refused to do, holding cryptically that "the drawings cannot properly

be referred to for the purpose of narrowing the claim." AN EXAMINATION OF THE DESCRIPTION OF THE SPECIFICATION ABOVE QUOTED REVEALS THAT THE TERM "FOOT COVER" IS FREQUENTLY USED AS AN EQUIVALENT OF THE TERM "UNDERSOCK", CLEARLY A REFERENCE TO THE FACT THAT THE SOCK WAS DESIGNED TO BE WORN BELOW THE LEVEL OF THE SHOE TOP.

The specification also states that the "undersock or foot cover . . . consists essentially of a rim having an integrated rubber thread and a body." The description goes on to point out that the "rim in the illustrated embodiment has a length of about one cm." One cm. is equal to .39 of an inch. Thus the rim of the patented product is effectually described as being of such a length that, when connected with a body which covers the tip, sole and heel portions of the foot, it would not extend above that portion of the foot which is located within the shoe. This is particularly true when we consider that the rim of the patented product is only about one cm. in length even before its length is shortened by being stretched upon the foot. According to the description in the specification, the length of the body is *not* made dependent upon some such criterion as the length of the sock desired to be manufactured but rather upon "the material used," such length being characterized by the description as from four cms. to six cms., or the equivalent of from one and a half to two and one-third inches, again before the sock is stretched upon the foot. This again evidences (1) an assumption that the foot cover is designed to remain below the level of the shoe top and (2) a scope which limits the proportions of the sock of the invention to an UNDERSOCK which remains below the level of the shoe top.

Finally, the description states that "FIG. 5 shows a foot cover in use." FIG. 5 IS THE ONLY DRAWING IN THE PATENT WHICH DEMONSTRATES THE MANNER IN WHICH THE FOOT COVER OF CLAIM 3 IS LOCATED ON THE FOOT OF THE WEARER AND IT

CLEARLY SHOWS ALL PORTIONS OF THE FOOT COVER BELOW THE ANKLE AND BELOW THAT PORTION OF THE INSTEP WHICH WOULD PROTRUDE FROM A LOW-CUT SHOE. In stating that "Claim 3 gives no particularity as to the part or shape of the foot or leg portion the rim contracts against, or where it is located relative to the instep, the Circuit Court refused to interpret the claim in the light of the description of the specification and the drawings. In this highly arbitrary action, it clearly violated basic principles of law enunciated by this Court and by other Circuit Courts of Appeals.

In quoting § 112 of Title 35 of the United States Code in its footnote #6, the Circuit Court omitted the last paragraph of that section, which reads as follows:

> "An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof."

Thus the language of Claim 3, "said body being adapted to function as tip, sole and heel portions of said foot cover," is within the express authorization of the last paragraph of § 112.

In "Commentary on the New Patent Act" by P. J. Federico, Examiner in Chief of the Patent Office at the time of the hearings before congressional committees, 35 U.S.C.A. 1 at 25, Mr. Federico makes the following statement with regard to § 112:

> "The last paragraph of section 112 relating to so-called functional claims is new. It provides that an element of a claim for a combination (and a combination may be not only a combination of mechanical elements, but also a combination of substances in a composition claim, or steps in the process claim) may be expressed as a means or step for performing a specified function, without the recital of structure, material or acts in support thereof. *It is unquestionable that some measure of greater lib-*

erality in the use of functional expressions in combination claims is authorized than had been permitted by some court decisions, and that decisions such as that in Halliburton Oil Well Cementing Co. v. Walker, 67 S.Ct. 6, 329 U.S. 1, 91 L.Ed 3 (1946) are modified or rendered obsolete, but the exact limits of the enlargement remain to be determined." (emphasis supplied)

Petitioners submit that the Circuit Court misunderstood the meaning of the last paragraph of § 112, if indeed that Court discerned its relevance at all; and this Court should allow this petition in order to provide the federal courts with much needed guidance in interpreting the above-quoted language.

To hold, as did the Circuit Court, that Claim 3 is invalid as overclaimed was in effect to hold that the "prior art" had disclosed a foot cover or undersock in which a rim with laid-in rubber was located below the ankle on that portion of the foot, and especially that portion of the instep, which is disclosed by the specification and drawings as being covered by the patented product in suit. This plainly is not true. As recognized in both opinions below, the combination of elments claimed is new, albeit each individual element *per se* is old; and one such element, the laid-in rubber in the rim, performs a new function in the combination, *i.e.*, that of "holding in place a sock located below the ankle and entirely within the shoe." Appendix for Appellant 13. Thus by all accepted criteria, the Sarbo foot cover is entitled to protection under the patent law.

That the Circuit Court erred in not giving proper weight to the specification and drawings of the Sarbo patent is evident from a recent decision of this Court, *United States* v. *Adams*, 86 S.Ct. 708, 713, 383 U.S. 39, 48 (1966), in which certain claims of the Adams patent were challenged on the ground that they did not mention a water electrolyte in them and the essence of the invention was the use of water in making the battery of the invention operative. This Court said:

"It is true that Claims 1 and 10, supra, do not mention

a water electrolyte, but, as we have noted, a stated object of the invention was to provide a battery rendered serviceable by the mere addition of water. *While the claims of a patent limit the invention, and specification cannot be utilized to expand the patent monopoly,* Burns v. Meyer, 100 U.S. 671, 672, 25 L.Ed. 733 (1880); McCarty v. Lehigh Valley R.Co., 160 U.S. 110, 116, 16 S. Ct. 240, 242, 40 L.Ed. 358 (1895), *it is fundamental that claims are to be construed in the light of the specifiaction and both are to be read with a view to ascertaining the invention,* Seymour v. Osborne, 11 Wall. 516, 547, 20 L.Ed. 33 (1871); Schriber-Schroth Co. v. Cleveland Trust Co., 311 U.S. 211, 312 U.S. 654, 61 S. Ct. 235, 85 L.Ed. 132 (1940); Schering Corp. v. Gilbert, 2 Cir., 153 F.2d 428 (1946). *Taken together with the stated object of disclosing a water-activated cell, the lack of reference to any electrolyte in Claims 1 and 10 indicates that water alone could be used.*" (emphasis supplied)

To paraphrase the *Adams* case, "taken together with the stated object of manufacturing a foot cover or undersock, which would necessarily be below the top of the shoe, the lack of reference to the exact location of the rim on the heel and instep of the foot in Claim 3 indicated that the rim was below the level of the shoe top." This conclusion is confirmed by the other language of the description and by FIG. 5 of the drawings.

In *Exhibit Supply Company* v. *Ace Patents Corporation,* 62 S.Ct. 513, 518, 315 U.S. 126, 135 (1942), in which this court was called upon to consider the meaning of the term "embedded" in a table as that term was used in a claim of the patent in suit there, this Court stated that "(T)he term is to be read as used in a permissible sense which would conform to the drawings and the function which the conductor to which the term was applied was obviously intended to perform."

The case of *Schriber-Schroth Co.* v. *Cleveland Trust Co.,* 59 S.Ct. 8, 13, 305 U.S. 47, 59 (1938), which was relied upon by the Circuit Court as the basis for its holding that Claim 3 was invalid for overclaiming, far from supporting that

conclusion, actually contradicts it. In holding that the Gulick and Maynard patents in suit there were invalid for overclaiming and for failure to describe the invention as required by the predecessor to § 112, the Court said:

> "As already indicated, the omission from the specifications was not supplied by the drawings, which failed to disclose by dimension the proportions of the webs.
>
> * * * * *
>
> "So far as they [the lower courts] relied on the drawings to supply the omission they disregarded the facts shown both by the inspection and by the evidence presented here that the drawings do no more to point to Gulick's invention than does the fact of inherent flexibility.
>
> * * * * *
>
> "As flexible webs are neither described in Maynard's specifications nor mentioned in his claims, they can be imported into them only by reference to the drawings or by inference from the inherent flexibility of the structure, which, for reasons already given in our consideration of the Gulick amendments, are insufficient to accomplish that result."

In other words, this Court indicated in the *Schriber-Schroth Co.* case that it is appropriate to interpret the claims in the light of the drawings and specification, which the Circuit Court refused to do in the present case. If it had done so, the disclosure of the specification and drawings would have made it clear that the patent in suit does not overclaim.

Ther are a number of cases in which this Court, although holding patents invalid for overclaiming where their specifications and drawings did not provide the assistance necessary to determine the limited nature of the claims, has indicated that, especially when the language of the claim is such that resort to the specification and drawings may be helpful in interpreting it, the courts should look to such specification and drawings for help in construing the claim.

> See: *Graver Tank & Manufacturing Co.* v. *Linde Air Products Co.*, 69 S.Ct. 535, 539, 336 U.S. 271, 277 (1949)

("While the cases more often have dealt with efforts to resort to specifications to expand claims, it is clear that the latter fail equally to perform their function as a measure of the grant when they overclaim the invention. When they do so to the point of their invalidity *and are free from ambiguity which might justify resort to the specifications,* we agree with the District Court that they are not to be saved because the latter are less inclusive.") (emphasis supplied)

Permutit Co. v. *Graver Corporation,* 52 S.Ct. 53, 55, 284 U.S. 52, 60 (1931) (Moreover, *while drawings may be referred to for illustration and may be used as an aid in interpreting the specification or claim,* they are of no avail where there is an entire absence of description of the alleged invention, or a failure to claim it. . . . *The free bed was neither described in the specification nor claimed in either Claim 1 or Claim 5.")* (emphasis supplied)

Halliburton Oil Wells Cementing Co. v. *Walker,* 67 S.Ct. 6, 11, 329 U.S. 1, 11 (1946) ("Neither in the specification, the drawing, nor in the claims here under consideration, was there any indication that the patentee contemplated any specific structural alternative for the acoustical resonator or for the resonator's relationship to the other parts of the machine.")

Other federal courts have recently followed the principle as enunciated by this Court. For example, in *Yosemite Chemical Co.* v. *United States,* 149 U.S.P.Q. 635, 639 (Court of Claims 1966), the Court of Claims, in upholding a patent, the validity of which was challenged on the ground that the patentee had overclaimed, said:

"Defendant urges also that the patent claims are inoperative due to overclaiming, in that they are so broad and generic in nature as to encompass a variety of chemical compounds that would not serve the function of the invention.

* * * * *

Broad statements of the law to the effect that a patent must describe the invention with a great degree of precision must be read in light of the cricumstances of each individual case. *Georgia-Pacific Corp.* v. *U. S.*

Plywood Corp., 258 F.2d. 124, 118 U.S.P.Q. 122 (2d Cir. 1958), cert. denied 358 U.S. 884, 119 U.S.P.Q. 501 (1958). The relevant patent statutes require that the claims be adequately described to indicate their true content and scope, but the disclosure called for need not be greater than that which is reasonable under the circumstances, having due regard to the nature of subject matter involved. *In re Hudson*, 205 F.2d 174, 40 C.C.P.A. 1036, 98 U.S.P.Q. 151 (1953). *The inventor is not to be deprived of the fruits of his labor by too technical a requirement of disclosure, and it is adequate for purposes of validity if his claims are sufficiently clear and exact to be understandable by those skilled in the relevant art. Lever Bros. Co.* v. *Proctor & Gamble Mfg. Co.*, 139 F.2d 633, 60 U.S.P.Q. 76 (4th Cir. 1943); *Hazeltine Research, Inc.* v. *Dage Elec. Co., Inc.*, 271 F.2d 218, 122 U.S.P.Q. 180 (7th Cir. 1949); *Research Prod. Co.* v. *Tretolite Co.*, 106 F.2d 530, 43 U.S.P.Q. 99 (9th Cir. 1939). In the present suit the evidence as a whole fails to corroborate defendant's assertion, based upon the *Chesterfield* case, supra, that substantial experimentation would have to be undertaken to determine which compounds fa' ng within the literal range of the claims would be effective for use in the removal process. * * * *Moreover, the patent specification assists those who would practice the invention by identifying certain chemical compositions that do in fact work.* See *Union Oil Co. of Calif.* v. *American Butumuls Co., supra.* Thus, although it can be said that the general te.m "fatty acid or organic soap of a divalent metal" may technically encompass certain inoperative species, the claims, by themselves, *or as read in light of the specification,* may be readily comprehended by those skilled in the art, do not cover inoperative species, and would pose no particular problems in application." (emphasis supplied)

* * *

Thus, the Fourth Circuit's holding in the principal case is in direct conflict with the Court of Claims.

Patentees are generally allowed much latitude in terminology and the language that they use will be given the meaning which is intended by them if it can be ascertained

from the context. This principle, that it is appropriate in determining the limits of the patent to consult the drawings and specification, has been adopted by many other circuits and is frequently referred to as "axiomatic." For example, in *Lincoln Stores* v. *Nashua Mfg. Co.*, 157 F.2d 154, 158 (1st Cir. 1946), cert. denied 67 S.Ct. 623, 329 U.S. 811 (1947), the United States Court of Appeals for the First Circuit, in upholding certain patent claims made the following statement:

> "The defendant challenges claim 7 of the Amory patent as not meeting the standards of clarity required by R.S. § 4888, 35 U.S.C.A. § 33, because it is impossible to determine whether a given blanket infringes the patent. This challenge is based on the defendant's assertion that the word 'staple' as used in the claim has no exact meaning. * * * The district court held, however, that the word 'staple' as commonly used in the rayon industry and as used in this patent, means a filament cut to a predetermined length and that *this definition read in the light of the specifications requires that the filling wrapping contain fibers of a predetermined length, preferably 1" to 2"*, and it concluded that there was no difficulty in deciding which blankets infringe and which do not. We agree with the district court.
>
> *Patentees are allowed much latitude in terminology and the language they use will be given the meaning intended by them if it can be ascertained from the context. Strong-Scott Mfg. Co.* v. *Weller*, 8 Cir. 1940, 112 F.2d 389, 394. *It is immaterial that we must refer to the specications for an understanding that the fibers are to be cut to a length of between 1" to 2". Skinner Bros. Belting Co.* v. *Oil Wells Improvements Co.*, 10 Cir. 1931, 54 F.2d 896, 899." (emphasis supplied)

In *Wyott Manufacturing Co.* v. *Doran Coffee Roasting Co.*, 160 F. Supp. 644, 648, (D. Col. 1958) mod. on other grounds 267 F.2d 200 (10th Cir. 1959), a Colorado District Court upheld patent claims against the charge of indistinctiveness in the following language:

> "The final affirmative defense is that the Titus patent was invalid for indistinctiveness. Here it is asserted

> that the claims disclose a patent ambiguity by describing the leg bottom variously as "concave" and "convex from the under side." However, the leg bottom was *illustrated in a similar manner in each of the illustrations, and these drawings may be referred to in order to construe any ambiguity in the claims. Permo, Inc.* v. *Hudson-Ross, Inc.*, 7 Cir., 1950, 179 F.2d 386; *Chicago Forging & Mfg. Co.* v. *Bade-Cummings Mfg. Co.*, 6 Cir., 1933, 63 F.2d 928. See also, Walker on Patents, Deller's Ed. Sec. 262. Taken together, there could be no real doubt as to what was meant by the description, and any mechanic skilled in the art could have constructed the device from the description in the claims and specification. *Where this is so, the patent will not fail for ambiguity, although more accurate language could perhaps have been used.* 35 U.S.C.A. § 112." (emphasis supplied)

In *Winget Kickernick Co.* v. *Kenilworth Mfg. Co.*, 11 F.2d 1, 2 (2nd Cir. 1926), the Second Circuit Court upheld patent claims against a charge of indistinctiveness as follows:

> The appellant argues that there is nothing in these claims which clearly advance the characteristics of a front member and of a back member, but *the court may look at the specifications and drawings to determine the characteristics and meaning of the elements recited in the claim. The language does not mean any kind of front member, or any kind of back member, but it is that kind of member, front or back, which is shown and described in combination with the other elements recited in the claims.* This describes the principle of construction and the invention to be protected." (emphasis supplied)

Moreover, contrary to the position taken by the Circuit Court in the principal case, other federal courts have specifically held that the drawings accompanying the specification may be referred to in order to ascertain the true meaning of the terms used in describing the invention and have limited claims by the structures which appeared in the drawings.

See:

Krauth v. *Autographic Register Company*, 285 F. 199,

206, (D.C.N.J. 1921) revd. on other grounds, 286 F. 240. ("While the specification and claims are silent as to the particular shape of the pins, if it be considered necessary that this should be made known, attention is called to the fact that the drawings, in connection with which the claims and specification must be construed, disclose their shape.");

Waterloo Cement Machinery Corp. v. *Engle*, 240 F. 976, 978, (2nd Cir. 1917) ("It is not essential that the claim shall describe in detail each element of the combination; it is enough if these details are shown in the description and drawings.");

Steiner and Voegtly Hardware Co. v. *Tabor Sash Co.*, 178 F. 831, 836 (C.C.N.J. 1910) ("The drawings accompanying the specification and referred to in the descriptive parts thereof will be examined to ascertain the true meaning of the terms used in describing the invention.")

The effect of the Circuit Court's refusal to give due weight to the specification and drawings in the principal case in construing Claim 3 is to violate the principle enunciated in its own earlier decisions. In *Black and Decker Mfg. Co.* v. *Baltimore Truck Tire Service Corp.*, 40 F.2d 910, 914 (4th Cir. 1930), in reversing a holding of invalidity by the lower court, the 4th Circuit said:

"It is said that the fifty claim is too broad and is anticipated by the Witherell patent. We do not think so. * * * Furthermore, *it is elementary that the language of the claims is to be construed in the light of the description and drawings. Hogg* v. *Emerson*, 11 How. 587, 13 L.Ed. 824; *Wicke* v. *Ostrum, supra*, 103 (C.C.A. 7th) 215 F. 586. And, when so construed, there can be no question that the language used refers to a device for ascertaining the wheel load on motor vehicles and not to such devices as that covered by the Witherell patent. *While it is true that courts will not ordinarily interpret a positively recited generic expression as limited to the precise instrumentality disclosed by the patent, they will do even this where such narrow interpretation is necessary to distinguish the claim from the prior art*

> *and uphold the validity of the claim.*" (emphasis supplied)

Plainly, the term "foot cover" is a term which the court should have treated as relating by the custom of the trade to a sock which is concealed beneath the level of the shoe top, or else a term which required the court to consult the specification and drawings for further definition. By refusing to consult the drawings and specification to see that the claims referred to an UNDERSOCK and thus did not include the prior art, the court disregarded its own precedents as well as those of this Court and other federal courts.

Judge Learned Hand phrased this principle as follows in *Bragg-Kliesrath Corp.* v. *Walter S. Vogel & Co.*, 67 F.2d 531, 532 (2nd Cir. 1933):

> "Patent claims are peculiar in that in a proper case courts will save them by limiting their expressed intent to so much of the field as the prior art leaves open; this is the converse of the doctrine of equivalents."

In applying the doctrine of equivalents and thus relieving persons charged with patent infringement of liability, federal Circuit Courts of Appeals have very recently reiterated the principle that any ambiguity in claims is to be resolved in the light of the specification and drawings in order to limit such claims. For example, in *Illinois Tool Work, Inc.* v. *Brunsing*, 156 U.S.P.Q. 610, 611 (9th Cir. 1968), the 9th Circuit made the following statement:

> "As the findings of fact indicate, the trial court construed the patent claims in light of the specification and drawings. This was appropriate procedure, *the rule being that the specification and drawings must be looked to in order to properly grasp the invention or explain any ambiguity in the claims.* It is also to be borne in mind that the specification may not be used to enlarge a claim, but *can be used to limit the claim.*" (emphasis supplied)

See also *DelFrancia* v. *Stanthony Corporation*, 278 F.2d 745, 747 (9th Cir. 1960); rehearing denied 1960;

Victor Cooler Door Co. v. *Jamison Cold Storage Door*

> *Co.*, 44 F.2d 288, 291 (4th Cir. 1930) (It is elementary that the language of the claims is to be construed in the light of the specification and drawings . . . *In view of the state of the prior art, to which we shall hereafter refer, the claim must be held limited to this particular device in order that the validity of the patent may be upheld.*") (emphasis supplied)

The Fourth Circuit Court's reliance upon the case of *Binks Mfg. Co.* v. *Ransburg Electro-Coating Corp.*, 281 F. 2d 252 (7th Cir. 1960) in supporting the principle that drawings cannot properly be referred to for the purpose of narrowing the claim was ill-placed. There the Seventh Circuit Court held that the principle enunciated in the claims was broader than that of the drawings and that the claims were nonetheless *valid* in a form which read upon the defendant's infringing device. There is certainly nothing inconsistent with this principle of equvalents and the principle for which the petitioners are contending in the case at hand. Indeed, the *Binks* court specifically held that the invention in that case was *not* overclaimed and cited the third paragraph of § 112 to support the right of the patentee to express an element of his claim in terms of a specified function rather than a structure, when the structure is included in the specification.

Likewise, the case of *Wilcox Mfg.* v. *Eastern Gas and Fuel Associates,* 400 F.2d 960 (D.C.W.Va. 1967) which was cited by the Circuit Court to support the same proposition, is not apposite. There the plaintiff patentee sought to broaden the scope of its patent claim in order to cover the defendant's device charged to infringe, rather than seeking to limit such claims; and there was nothing in the specification and drawings to support such *broader* scope.

Similarly, the cases which were cited by the respondent in its brief in the Circuit Court, *application of Custer,* 173 F.2d 226 (C.C.P.A. 1949) *in re Laurent* 186 F.2d 741 (C.C.P.A. 1951) and *application of Edwards,* 285 F.2d 811 (C.C.P.A. 1961), are all distinguishable from the principle case in that those cases the language of the claims in issue

was self-sufficiently broad and therefore there was no occasion to read that language in the light of the specification and drawings. In the case at bar, on the other hand the term "foot cover" is typical of terminology as to which the Court will consult the specification and drawings in order to determine its meaning as an UNDERSOCK.

2. The Court of Appeals erred by imposing too rigorous a test of particularity in holding that 35 U.S.C. § 112 requires the claim in suit to specify the particular loca- of the laid-in rubber rim on the foot of the wearer.

Much of what petitioners have already said in connection with the previous discussion of the Circuit Court's error in refusing to interpret Claim 3 in the light of the specfication and drawings is also applicable here. The effect of its holding of invalidity was to compound the same grievous error by also refusing to consult the specification and drawings in testing the patent by the requirements of 35 U.S.C. 112, which calls for particularity in the claims with respect to the subject matter constituting the invention.

Reference to the specification and drawings makes it clear that the invention claimed relates to a sock which is concealed beneath the level of the shoe top. There was no necessity for the patentee to define the location of the laid-in rubber rim any more definitely than that. Indeed, in footnote #5 of the opinion of the Court of Appeals, the Court of Appeals itself suggested that the petitioner might have articulated his invention by adopting language similar to that of the Herbert U. S. Patents which recite, "A slipper type foot covering of such height as to be completely concealed from view when worn within an outer pump or other such lower cut shoe. . . ." By reference to the specification and drawings for the definition of the term "foot cover" and the structure included within the meaning of the last phrase of Claim 3, the Court of Appeals would easily have ascertained that Sarbo was claiming his invention in just the type of sock which is concealed below the level of the shoe.

In *Georgia-Pacific* v. *United States Plywood Corp.*, 258 F.2d 124, 135 (2nd Cir. 1958), cert. denied 358 U.S. 884 (1958), Judge Lumbard restated the basic principles with respect to the precision required in order to satisfy the provisions of section 112 as follows:

> *"It has often been stated that the scope of claims should be limited in light of the specifications if necessary to uphold the patent,* see e.g. *Westinghouse Electric & Mfg. Co.* v. *Quackenbush*, 6 Cir., 1931, 53 F.2d 632, 634, 1111. *The rule applies only if the claims are ambiguous . . .*
>
> We think that the district court was too rigorous in applying the requirement of precision. *This requirement serves two primary purposes: those skilled in the art must be able to understand and apply the teachings of the invention and enterprise and experimentation must not be discouraged by the creation of an area of uncertainty as to the scope of the invention. On the other hand, the policy of the patent statute contemplates granting protection to valid inventions, and this policy would be defeated if protection were to be accorded only to those patents which were capable of precise definition.* The judicial function requires a balancing of these competing considerations in the individual case.
>
> It is true that the Supreme Court has stated that "(a)n invention must be capable of accurate definition, and it must be accurately defined, to be patentable," *United Carbon Co.* v. *Binney & Smith Co.*, 1942, 317 U.S. 228, 237, 63 S.Ct. 165, 170, 87 L.Ed. 323, and this Court recently stated that "* * * the requirement of the Act for definiteness in the statement of claims must be strictly construed,; Helene Curtis Industries, Inc. v. Sales Affiliates, supra, 233 F.2d at page 160. Such general statements, however, must be viewed in the context of circumstances. *Objectionable indefiniteness must be determined by the facts in each case, not by reference to an abstract rule. Chicago Pneumatic Tool Co.* v. *Hughes Tool Co.*, 10 Cir., 1938, 97 F.2d 945, 948 certiorari denied 305 U.S. 643, 59 S.Ct. 146, 83 L.Ed. 415. ** * * If the claims, read in the light of the specifications, reasonably apprise those skilled in the art both of the*

utilization and scope of the invention, and if the language is as precise as the subject matter permits, the courts can demand no more. See *Lever Bros. Co.* v. *Proctor & Gamble Mfg. Co.*, 4 Cir., 1943, 139 F.2d 633, 639; *H. H. Robertson Co.* v. *Klaur Mfg. Co.*, 8 Cir., 1938, 98 F.2d 150, 153. That an area of uncertainty necessarily exists in such a situation cannot be denied, but the existence of an inescapable area of uncertainty is not sufficient justification for denying to the patentee the fruits of his invention.

Indeed, in the administration of the patent statutes uncertainty has been introduced by express judicial creation. It has often been stated that the scope of the patent is limited by the language of the claims. Where, however, an infringer has attempted to appropriate the essence of the invention while remaining outside the language of the claims, courts have not hesitated to apply the doctrine of equivalents, whereby the 'essence' of the invention is protected. See *Claude Neon Lights* v. *E. Machlett & Son.*, 2 Cir., 1929, 36 F.2d. 574, certiorari denied 281 U.S. 741, 50 S. Ct. 347, 74 L.Ed 1155. In such situations the patentee is protected even though he has been more precise than the subject matter of the invention permits or requires. *It would be anomalous if this Court were to strike down a patent created by the language of the specifications and claims rather than by judicial application of equivalency doctrine.*

* * * * *

"This inevitable imprecision, however, is not fatal, *Claim 1, read, as it must be, in the light of the specifications and drawings* [*H. H. Robertson Co.* v. *Klauer Mfg. Co., supra; Chicago Pneumatic Tool of Newton, Mass.* v. *Coe*, 1938, 68 App. D.C. 255, 96 F.2d 527] *reasonably indicates to the industry the teachings and the the scope of the patent. . . . Although the two drawings of the patent are concededly diagrammatic rather than to scale, they convey a visual perspective which aids in the interpretation of the claim.*

* * * * *

"Here both the specification and the claim to some extent interrelate a description of configuration and function, but we think the latter merely aids in understanding the scope of the patent. The patentee is not

> *attempting to claim a function, stress relief, and all the manifold ways of obtaining it, thus claiming more than his invention.''* (emphasis supplied)

Under the test enunciated in the *Georgia-Pacific* case, it is enough that the claim as read in the light of the specification and drawings enables a person skilled in the art to make and use the invention and limits the scope of the invention.

It is clear that the respondent Russell Hosiery Mills was able to understand the Sarbo patent sufficiently to make and use the invention of the petitioners in the principal case, as the respondent admits having copied petitioners' sock. The sock which he copied is essentially the one which is illustrated in FIG. 5 of the patent and described in the specification. It is also clear that Sarbo's Claim 3, as interpreted in the light of the specification and drawings, shows that the laid-in rubber rim of the sock, as well as the remaining portions of the sock, were concealed below the level of the shoe, thus limiting the scope of the patent.

The same principle has been recently enunciated by the United States Court of Appeals for the 3rd Circuit in *Jones Knitting Corp.* v. *Morgan*, 361 F.2d 451, 453 (3rd Cir. 1966), rehg. den. 1966. There in upholding patent claims against a charge of invalidity for failure to satisfy the requirements of § 112, the Court made the following statement:

> ''Regardless of the fact that the term ''heat-insulating'' may be one of degree, there is abundant evidence on this record taken as a whole that when one skilled in the art reads the Moragn Patent, he would be capable of producing the patented fabric and of determining the limits of the patent. As we interpret the statutory standard, this is all the inventor need show. 35 U.S.C.A. § 112.
>
> * * * * *
>
> ''These references suffice for us to state, in summary, our conviction that the evidence shows that the patent teaches with sufficient conciseness how the invention might be put into use and also gives sufficient warning to the would-be infringer of the patent's limits. *The*

fact that the patent also uses a term capable of only relative definition is not fatal.'' (emphasis supplied)

See also: *Corning Glass Works* v. *Anchor Hocking Glass Corp.* 374 F.2d 473, 477 (3rd Cir. 1967)

The 6th Circuit has recently made it clear that it subscribes to the same principle. In *Tilotson Mfg. Co.* v. *Textron, Inc., Homelite,* 337 F.2d 833, 840 (6th Cir. 1964), against the charge that the patent in suit in that case was invalid for failure to satisfy § 112, the Court held that the patent was sufficiently definite and made the following further statement:

> ''Appellant relies on 35 U.S.C. § 112 (1952).
> There is noting vague or confusing about this claim to a person skilled in the carburetor art. *It must be interpreted in the light of the specification and drawings.* The test is whether the disclosures make the invention clear to a mechanic skilled in the art so that he could construct the carburetor and use it. *Schriber-Schroth Co.* v. *Cleveland Trust Co.,* 311 U.S. 211, 61 S.Ct. 235, 85 L.Ed. 132 (1940).
> *Whether the patent properly describes the invention so as to enable any person skilled in the art to make and use it must be determined by consideration of the specification, drawings, claims and the other evidence in the case.''*
>
> * * * * *
>
> ''Nor do we believe that the location of the diaphragm in the carburetor requires experimentation of the type condemned by the patent law. *A specific example of the carburetor was given in the specification. The fact that some testing may be required in calibrating carburetors for different engines does not render the claims indefinit where adequate guideposts were furnished as here.''* (emphasis supplied)

See also:

Hawkinson Co. v. *Wilcoxen,* 149 F.2d 471, 475 (6th Cir. 1945);
H. H. Robertson Co. v. *Klauer Mfg. Co.,* 98 F.2d 150, 153 (8th Cir. 1938);
Chicago Pneumatic Tool Co. v. *Hughes Tool Co.,* 97

F.2d 945, 948 (10th Cir. 1938); cert. denied 305 U.S. 643, 59 S.Ct. 146;
Ideal Roller & Mfg. Co. v. *Sutherland Paper Co.*, 96 F.2d 675, 677 (6th Cir. 1938).

Thus it is clear that most of the other federal Circuit Courts have adopted the view that § 112 was not intended to deprive Sarbo of the right to have his specification and drawings referred to for the purpose of determining the meaning of words such as "foot cover" in the claim, but rather that it was intended to continue such principle in force, and indeed to liberalize it, in the sense of expressly authorizing the statement of one of the elements in functional terms. In departing from this principle, the Fourth Circuit has invited the attention of this Court to resolving the conflict.

CONCLUSION

For the reasons set forth in this petition we respectfully submit that certiorari should be granted.

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